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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	78551005
Applicant	Darin Chase
Applied for Mark	HOMESITE MORTGAGE
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	**Darin Chase**
Trademark:	**HOMESITE MORTGAGE**
Serial No.:	**78/551005**
Filed:	**January 20, 2005**
Examining Attorney:	**John E. Michos, Law Office 105**

APPLICANT'S REPLY BRIEF IN SUPPORT OF REGISTRATION OF THE HOMESITE MORTGAGE MARK

Commissioner for Trademarks
P.O. Box 1451
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ARGUMENT

The Applicant respectfully disagrees with the Examining Attorney's assertion in the Examining Attorney's Appeal Brief that "the marks of the Applicant and the Registrant are highly similar and the services are so related such that there exists a likelihood of confusion, mistake, or deception under Section 2(d) of the Trademark Act."

A. THE MARKS ARE NOT CONFUSINGLY SIMILAR

As previously noted in the Applicant's Appeal Brief, in determining whether confusion is likely to exist between two marks, the United States Patent and Trademark Office examines the marks in light of the factors set forth in *In re E.I., du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973); *see* TMEP § 1207.01. The relevant factors in this matter include: (1) the dissimilarity of the respective marks as

to appearance, sound, connotation and commercial impression; (2) the nature of the goods cited in the application; and (3) the conditions under which sales of the respective products or services take place. *See du Pont,* 476 F.2d at 1362. The mere fact that a "similarity" may arguably exist among various marks does not automatically mandate a finding of a likelihood of confusion.

Applicant's mark is not likely to be confused with the above cited registrations because the HOMESITE MORTGAGE mark is distinguishable in appearance, sound, connotation and commercial impression and because the services associated with the respective marks are dissimilar. Further, there is no likelihood of confusion because the services associated with the HOMESITE MORTGAGE mark and the cited registrations are highly regulated and are purchased by extremely sophisticated customers who will necessarily exercise a great deal of care in determining the source of the services.

As noted, the HOMESITE MORTGAGE mark is distinguishable from the cited registered marks as to appearance, sound, connotation and commercial impression. A likelihood of confusion analysis cannot be predicated on dissection of a mark, but rather, marks must be compared in their entireties and must be considered in connection with the particular goods for which they are used. See *In re Nat'l Data Corp*., 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985); see also TMEP § 1207.01. Further, the marks must be considered as they are encountered in the marketplace. *Alpha Industries, Inc. v. Alpha Steel Tube & Shapes, Inc.,* 616 F.2d 440, 445, 205 USPQ 981 (9th Cir. 1980).

Here, the Examining Attorney has purposely chosen to lop off the "mortgage" portion of the Applicant's mark and conduct her analysis solely on the basis of the "homesite" portion of the Applicant's mark in comparison to the "homesite" portions of

the cited registrations. This is clearly improper. The analysis should have been conducted on the basis of the whole mark that is sought to be registered. Taking this type of "dissected" examination to the extreme, the Examining Attorney could take a single syllable, or perhaps even a single letter, and declare "similarity" and thus likelihood of confusion between two or more competing marks.

Furthermore, the Examining Attorney stated that because the cited registrations use "highly descriptive or generic terms" in connection with their marks and the Applicant uses the "generic term 'MORTGAGE'," as allegedly further proof of a likelihood of confusion. If the respective terms are allegedly "highly descriptive or generic" would this not cut against the Examining Attorney's assertion? If the cited registrations use descriptive or generic terms such as "insurance," "home insurance," and/or "indemnity," do they not serve to alert the ordinary consumer of the respective services being offered, just as the term "mortgage" would also alert the ordinary consumer that that particular service is being offered in conjunction with the respective mark? The Examining Attorney's position seems to be that the Registrant of the cited registrations has been using generic/descriptive terms in conjunction with the "homesite" portion of the marks, and therefore because the Applicant also uses an allegedly generic/descriptive term in conjunction with its mark, therefore there is a likelihood of confusion among the marks. What if the Applicant was attempting to register the mark "HOMESITE MANURE" for use in fertilizing lawns? Manure is supposedly a generic/descriptive term just like "insurance," "home insurance," and/or "indemnity." Lawns are "ultimately" related to real estate. Would the Examining Attorney also find a likelihood of confusion for that hypothetical mark?

The Examining Attorney then chooses to include the term "mortgage" in her analysis when it suits her purposes as it relates to disclaimed matter. The Examining Attorney correctly noted that "a disclaimed portion of a mark certainly cannot be ignored, and the marks must be compared in their entireties." However; this was not done. The Examining Attorney has taken the position that "homesite" is the dominant portion of the Applicant's, as well as the Registrant's marks, and thus has effectively removed the "mortgage" portion of the Applicant's mark from consideration. Just because a word has been disclaimed does not necessarily mean that it is not or cannot be the dominant portion of a mark. Disclaimers can be done for any number of strategic reasons during the course of prosecution. In this instance, the word "mortgage" in the Applicant's mark (as well as the disclaimed portions of the Registrant's marks) conveys a great deal of information to the ordinary consumer that would create a strong commercial impression thereupon. The Examining Attorney argues that the disclaimed words "mortgage" and the disclaimed words of the Registrant's marks (e.g., insurance, home insurance, indemnity and renters express) provide "little distinctive value when comparing the marks." The Applicant cannot disagree more with the Examining Attorney's assertion. These disclaimed words would be of critical importance when determining what services these respective marks are associated with and further, which sources are associated with the respective marks. Furthermore, the fact that the word "homesite" appears before the word "mortgage" in the Applicant's mark does not necessarily mean one has more import than the other because of their relative placement. As previously noted, the Applicant contends that the word "mortgage" has as much as and possibly more importance than "homesite" when individually compared to one another. However, it is the mark as a

whole that needs to be analyzed and examined, as opposed to each word that comprises the mark. Again, the Examining Attorney is improperly attempting to dissect the Applicant's mark to its constituent pieces. An ordinary consumer, seeking out mortgage services, does not go to a telephone directory under the heading of "h" looking for "homesite" entries. Likewise, an ordinary consumer, seeking out insurance services, does not go to a telephone directory under the heading of "h" looking for "homesite" entries.

With respect to the Examining Attorney's comments regarding the weakness of the cited registrations, the Applicant, in its Appeal Brief at pages 8-9, was merely pointing out to the Board that multiple registrations having the same "root word" or even identical words can indeed co-exist, especially when those marks relate to different industries such as mortgage lending, real estate, and insurance. The situation among the various "central" marks discussed therein is completely analogous to the instant situation.

B. THE SERVICES ARE NOT RELATED

As previously noted in the Applicant's Appeal Brief, confusion as to the source of the HOMESITE MORTGAGE services is unlikely where the associated "mortgage lending services" are entirely dissimilar to the "insurance services" and "real estate services" of the cited registrations. In comparing the services of the marks for the purpose of determining likelihood of confusion, the nature and scope of the services must be determined on the basis of the goods or services recited in the application or registration. TMEP §1207.01(a)(iii) (citing *Hewlett-Packard Co. v Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002)) (other citations omitted).

The HOMESITE MORTGAGE application lists "mortgage lending services" (as amended) as the associated services whereas the cited registrations list, among other things, "insurance services," "real estate services, namely, real estate listing, property management and agency services," and "on-line database inquiry and posting services in the field of real estate." The Examining Attorney has taken the position that the services of the parties "need only be related in some manner." However, as set forth in the Applicant's Appeal Brief, the services of the cited registrations are completely different from that associated with the Applicant's mark.

The only common denominator in the present case is that "mortgage lending services" and "insurance services" for real estate, "real estate services, namely, real estate listing, property management and agency services," and "on-line database inquiry and posting services in the field of real estate," are, in an extremely general sense, related to the field of real estate. Yet, this is where the similarity ends. Listing services and property management services are very different from mortgage lending services, which require that a provider have an extensive financial background and understanding. Mortgage lending is also very different from insurance services. Additionally, buyers purchase insurance and mortgages for extremely different reasons. Whereas an individual or entity applies for and obtains a mortgage (after a lengthy process) as a means to acquire property, an individual or entity purchases insurance (after a very short process) for risk management purposes.

With respect to the recitation of the services of the Applicant's registration application, the Examining Attorney did not require that a limitation be placed on "the nature, type, channels of trade or classes of purchasers" and, accordingly, the Applicant

contends that it is improper to now accuse the Applicant of failing to do so. The recitation of services speaks for itself. Furthermore, the Examining Attorney's concept of "normal fields of expansion" appears to be overly broad. Even the decision cited by the Examining Attorney's in 1st USA Realty Professionals, Inc., Serial No. 78553715 (TTAB August 7, 2007) undercuts her position when it states, at page 8, that "the expansion of trade doctrine has a more limited application in an ex parte proceeding (citing In re General Motors Corporation, 196 USPQ 574 (TTAB 1977).

While the Applicant is not asserting that mortgage lending services and insurance/real estate services can never emanate from the same source, the Applicant asserts the marks must be compared in their entireties in light of their respective recitations and that blanket assumptions cannot be made. For example, the third party marks cited in the Examining Attorney's Appeal Brief at pages 8-10, while arguably illustrating that various services can emanate from a single source, are nonetheless all vastly different from one another, and thus are not relevant to the instant application. This evidence was apparently presented by the Examining Attorney in response to a simple statement by the Applicant that the mortgage lending and insurance industries are separate and heavily regulated, and thus appropriate information (e.g., alerts, warnings, disclaimers, and so forth) is typically presented to consumers during any exposure thereto. Furthermore, the Examining Attorney's reliance on the 1st USA Realty Professionals, Inc. decision is misplaced, as in that case, the cited registration included a recitation that included **both** banking services and insurance underwriting services, among other things. None of the relied upon cited registrations by the Examining Attorney contain recitations that include mortgage lending services **and** either insurance

and/or real estate services. Accordingly, the Board in the 1st USA Realty Professionals, Inc. decision was faced with a different factual situation than presents itself here. Therefore, extrapolating what the Board should hold based on the instant facts in light of the 1st USA Realty Professionals, Inc. decision does not take into account those factual differences.

Further, as previously noted in the Applicant's Appeal Brief, no confusion is likely between the HOMESITE MORTGAGE and the cited registrations because the services associated with each respective mark are typically expensive, risky, and complex. Also, the prospective customers are generally very sophisticated, and prospective customers will necessarily exercise a great deal of care in determining the source of the services. Again, the supposition that any number of services "may emanate" from a single source is not a reliable or appropriate standard for determining whether or not a likelihood of confusion exists between two or more marks.

Reiterating, the Applicant provides mortgage-lending services whereas the registrants of the cited marks provide insurance services. Mortgages and insurance policies both involve sophisticated and often complex terms requiring considerable thought and evaluation by prospective purchasers. However, mortgages (even adjustable rate mortgages) are often purchased for a large number of years (e.g., 15 or 30-year mortgages), and for typically hundreds of thousands of dollars. Insurance policies, for whatever their purpose, typically are purchased or renewed on an annual basis, with premiums running in the hundreds and possibly the low thousands of dollars. Moreover, both the mortgage lending and insurance industries are highly regulated. No consumer, of even dubious sophistication, will be confused into patronizing a mortgage company

when attempting to purchase insurance for his/her motorcycle or speedboat. Even purchasers of "real-estate" related insurance policies (e.g., renters or homeowners insurance policies) will understand the difference between applying for a multi-hundred thousand dollar mortgage (which could take weeks and even months to close) and almost instantaneously applying for and purchasing a renters or homeowners insurance policy for a few hundred or even a couple of thousand dollars. No doubt, prospective customers will be acutely aware of the respective companies/sources that are providing these services, thereby eliminating any possibility of confusion. Furthermore, the Applicant is unaware of any legal authority that supports the Examining Attorney's position that purchasers need to be "sophisticated or knowledgeable in the field of trademarks" to obviate a likelihood of confusion rejection.

As previously noted, the Examining Attorney seems to have based the refusal to register the proposed mark on the similarity of mortgage lending services and homeowners, renters, and property insurance services, reasoning that because these services frequently emanate from the same source, customers would be likely to conclude that Applicant's mortgage lending services were associated with or sponsored by the Registrant. As pointed out in the Applicant's Appeal Brief, *Allstate Ins. Co. v. Allstate Investment Corp.*, 210 F.Supp. 25, 30 (W.D. La. 1962), *aff'd Allstate Ins. Co. v. Allstate Investment Corp.*, 328 F.2d 608 (5th Cir. 1964) rejected the notion that mortgage lending services and insurance services are so similar as to cause confusion in the public mind. The Examining Attorney countered that "current trends" of integrating these services render the *Allstate Ins. Co.* decision "less persuasive." It is the Applicant's understanding that the *Allstate Ins. Co.* case, affirmed by the United States Fifth Circuit Court of

Appeals, is still good law and has not been overruled, and thus should be accorded appropriate deference over a supposed "current trend."

Furthermore, to take the Examining Attorney's reasoning to the extreme, any marks pertaining to services such as home inspection, plumbing services, heating and ventilation services, termite eradication services, asbestos remediation services, or even lawn mowing services could all ***ultimately*** "emanate from the same source." The field of "real estate," which forms no part of the recitation of the HOMESITE MORTGAGE mark, is too broad to provide a basis for refusal of the instant mark.

CONCLUSION

For the reasons set forth above, Applicant submits that there is no likelihood of confusion between Applicant's mark and the prior cited registrations. Accordingly, Applicant respectfully requests that the refusal of registration be withdrawn and prays that the application for the HOMESITE MORTGAGE mark be approved for publication.

Respectfully submitted,

Dated: September 25, 2007

/jeffrey a. sadowski/

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